REMARKS

Claim 18 was amended to clarify that the claimed ratio of particle sizes refers to the ratio of filler particle size to synthetic organic polymer particle size. Claim 19 was amended to clarify that the claimed particle size refers to the synthetic organic polymer particle size. Support for these amendments appears in the claims 1 and 2 as filed; no new matter has been added.

Claims 18-39 stand rejected as anticipated by U.S. 6,140,394 to Kamiyama et al. Applicants respectfully traverse.

The reference does not explicitly describe all the elements of claim 18, and so the rejection fills the gaps by presuming: 1) that the claimed polymeric molecular weight of more than 600 is inherently present in Kamiyama; 2) that the inorganic additives of Kamiyama are filler particles as claimed; and 3) that the inorganic additive powders of Kamiyama have a size of at least 200 microns so that the particle size ratio as claimed is present. Since anticipation requires the presence of each element in the reference, if any one of these elements is not inherent in Kamiyama, then the rejection must fail.

Inherency is established only where a claimed characteristic or element that is not described in the reference necessarily and inevitably results from the teachings of the prior art. To rely upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to show that the allegedly inherent characteristics necessarily flow from the cited art. *Ex parte Levey,* 17 U.S.P.Q.2d 1461 (BPAI 1990). Inherency must be a necessary result, not merely a possible result, *In re Oelrich,* 666 F.2D 578, 212 U.S.P.Q. 323 (CCPA 1981); *Ex parte Keith,* 154 U.S.P.Q. 320 (POBA 1961). See also, *In re Robertson,* 49 U.S.P.Q.2d 1949, 1951 (Fed. Cir. 1999).

There is no evidence of record to support the contention that the claimed polymeric molecular weight of more than 600 necessarily results from the Kamiyama process. No numerical molecular weights appear anywhere in the document. The general description identifies no desired molecular weights, nor do the examples report any actually achieved. It says that polymerization initiators can be used to control molecular weight and that temperature can adversely affect molecular weight, without teaching or suggesting any particular molecular weight, let alone the claimed one. Kamiyama at col. 10, lines 35-39 and 60-63. Achieving the claimed molecular weight may be *possible* under Kamiyama, but it is not, as the law requires for inherency, necessary. For this reason alone the rejection for anticipation is wrong.

The rejection states, "In view of the broad molecular weight limitation of the soluble polymer *being claimed*, the examiner has a reasonable basis that the claimed molecular weight of more than 600 is also inherently possessed in Kamiyama et al." Office Action at p.4 (emphasis added).

In other words, the rejection argues that *applicants' own claim* is evidence that Kamiyama's teachings necessarily result in a molecular weight of at least 600. Applicants' claims and disclosure are not prior art to themselves; evidence supporting inherency cannot be drawn from the claims under rejection. When one looks at the reference itself, there is no evidence suggesting that a molecular weight of more than 600 necessarily and inevitably results from the processes described. On the contrary, the document suggests that molecular weight is variable, without suggesting what specific molecular weights are desired. The inescapable conclusion is that the claimed molecular weight, while possible, is not inevitable, and therefore not inherent.

The chain of presumptions leading to the claimed particle size ratio is even more specious. Kamiyama teaches the incorporation of inorganic powders such as calcium sulfate and fine silica powders as suspension stabilizers in the polymerization. Kamiyama, col. 6, lines 43-45 and col. 9, lines 55-57. No mention is made of the properties of these powders, including particle size. After admitting the reference's utter silence on the point, and without a shred of supporting evidence, the rejection goes on to say that "it is well-recognized that the disclosed "powder" of Kamiyama is referring to a size range of at least 200 microns."

This is pure speculation. In fact, silica powders, for example, are known to have typical particle sizes well above and below 200 microns, as shown in the product literature for commercially available fine silica powders cited with this amendment. Kamiyama states no preference for any particular particle size, nor has any other evidence been cited that would have led one of skill to select the claimed particle size. As with the molecular weight, while it is possible to use a silica powder of at least 200 microns, nothing in Kamiyama discloses it, much less demands it, as is necessary to establish its inherency. Since a particle size of at least 200 microns in Kamiyama is not inevitable and therefore not inherent, it is manifestly *un*reasonable to conclude the claimed particle size ratio is inherent. For this reason as well, the rejection for anticipation over Kamiyama is not supported by the record.

CONCLUSION

In view of the amendments and remarks above, Applicants ask for reconsideration and allowance of all pending claims. Should any fees be due for entry and consideration of this Amendment that have not been accounted for, the Commissioner is authorized to charge them to Deposit Account No. 01-1250.

Respectfully submitted,

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